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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,523	09/27/2000	Kuriacose Joseph	2050.001US3	2175
44367 7590 06/13/2011 SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938				
EXAMINER GARG, YOGESH C				
ART UNIT 3625		PAPER NUMBER		
NOTIFICATION DATE 06/13/2011		DELIVERY MODE ELECTRONIC		

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* KURIACOSE JOSEPH,
9 ANSLEY WAYNE JESSUP JR.,
10 VINCENT DUREAU,
11 and ALAIN DELPUCH
12

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14 Appeal 2011-007916
15 Application 09/672,523
16 Technology Center 3600
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19 Before HUBERT C. LORIN, ANTON W. FETTING, and
20 MEREDITH C. PETRAVICK, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22
DECISION ON APPEAL

STATEMENT OF THE CASE¹

Kuriacose Joseph, Ansley Wayne Jessup Jr., Vincent Dureau, and Alain Delpuch (Appellants) seek review under 35 U.S.C. § 134 (2002) of a non-final rejection of claims 10, 11, 13-24, 27, 33, 38, 39, 41-43, 45-55, 57, 63, 260, and 262, the only claims pending in the application on appeal. This is a reissue application from application number 08/233,908, U.S. Pat. No. 5,819,034, issued October 6, 1998. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a client-server distributed computer system (Specification 1:5-6).

An understanding of the invention can be derived from a reading of exemplary claim 10, which is reproduced below [bracketed matter and some paragraphing added].

10. A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including:

[1] receiving, via a data stream from the server, item data, the item data including information to at least one of show and describe the item via the client and an item identifier to identify the item as currently being offered for sale;

[2] presenting at least a portion of the item data to a user;

[3] receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data;

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed November 17, 2010) and the Examiner's Answer ("Ans.," mailed January 12, 2011).

1 [4] responding to the single action by: retrieving personal
2 information of the user from a permanent memory in the client,
3 and
4 [5] combining the item data previously received via the data
5 stream from the server with the personal information of the user
6 previously stored in the permanent memory in the client to
7 generate an order for the item, and transmitting the order for the
8 item from the client.

9 Claims 10, 11, 13-24, 27, 33, 38, 39, 41-43, 45-55, 57, 63, 260, and 262
10 stand rejected under 35 U.S.C. § 251 as having a defective reissue
11 declaration because the error which is relied upon to support the reissue
12 application is not an error upon which a reissue can be based.

13 Claims 10, 11, 13-24, 27, 33, 38, 39, 41-43, 45-55, 57, 63, 260, and 262
14 stand rejected under 35 U.S.C. § 251 as being an improper recapture of
15 broadened claimed subject matter surrendered in the application for the
16 patent upon which the present reissue is based.

17 ISSUES

18 The issues of propriety of the declared error and recapture turn primarily
19 on whether the Appellants' described the error with any degree of
20 particularity and whether any of the claims are drawn to an invention similar
21 to those in any of the 9 original claims in the issued patent.

22 FACTS PERTINENT TO THE ISSUES

23 The following enumerated Findings of Fact (FF) are believed to be
24 supported by a preponderance of the evidence.

25 *Facts Related to Parent Patent U.S. 5,819,034*

01. The issued patent contained 9 claims.

02. All of those original claims are cancelled in the instant application.

03. All of those original claims are presented in divisional application [sic, see 7/10/2001 preliminary amendment] 09/903,458, whose prosecution is currently suspended pending allowability of one of the other reissue or divisional reissue applications.

04. All 9 claims in the issued patent covered an invention sending and receiving time division multiplexed packets. None of the claims in the instant application covers such an invention.

ANALYSIS

Claims 10, 11, 13-24, 27, 33, 38, 39, 41-43, 45-55, 57, 63, 260, and 262 rejected under 35 U.S.C. § 251 as having a defective reissue declaration because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based.

The Appellants' declarations state that they:

believe original U.S. patent no. 5,819,034 to be wholly or partly inoperative by reason of my claiming less than I had the right to claim in the patent. Specifically, the patent discloses a method and system that, stated generally, facilitate the presenting of data about an item being offered for sale to a user, and in response to a single action by the user, generating an order for the item. This invention is distinct from the invention claimed in the original patent; and is not in any way claimed in the patent.

1 The Examiner found:

2 “[t]his statement of error is not sufficient because it does
3 not identify a single word, phrase, or expression in the
4 specification or in an original claim (s) 1-9, and how it
5 renders the original patent wholly or partly inoperative or
6 invalid. The statement filed is no better than saying in the
7 reissue declaration that this ‘application is being filed to correct
8 errors in the patent which may be noted from the change made
9 by adding new claim 10’, see MPEP 1414, II, C.” Ans. 6.

10
11 Thus, the issue appears to be whether the reason provided by the
12 Appellants provided any specific detail. We find the phrase “facilitate the
13 presenting of data about an item being offered for sale to a user, and in
14 response to a single action by the user, generating an order for the item”
15 describing what the original claims omitted has sufficient specificity.

16 The portion of the MPEP the Examiner cites requires that the public be
17 put on notice as to the particular nature of the correction, and the reason
18 provided by the Appellants certainly describe generally the nature of the
19 claims that are to be added. This statement is more than merely being the
20 equivalent of stating “that the original claims did not cover certain
21 embodiments/language being presented by new claim 10” as the Examiner
22 found. One does not have to look at the specific claims being added to
23 appreciate the nature of the error being corrected. The most recent version
24 of the MPEP now has the following sentence prior to the portion cited by the
25 Examiner.

26 A statement of “failure to include a claim directed to” and then
27 presenting a newly added claim, would not be considered a
28 sufficient “error” statement because applicant has not pointed
29 out what the other claims lacked that the newly added claim
30 has, or vice versa.

1 MPEP 1414, II, C. Thus, this portion of the MPEP puts the phrasing
2 regarding hypothetical new claim 10, *supra*, in context as merely requiring
3 that the Applicants do more than just recite the added claim numbers and
4 contents without regard to the existing claims. Clearly the Appellants'
5 declaration has pointed out what the original claims lacked and the newly
6 claims have.

7 *Claims 10, 11, 13-24, 27, 33, 38, 39, 41-43, 45-55, 57, 63, 260, and 262*
8 *rejected under 35 U.S.C. § 251 as being an improper recapture of*
9 *broadened claimed subject matter surrendered in the application for the*
10 *patent upon which the present reissue is based.*

11 The Examiner found that none of the claims currently rejected are
12 directed to the same invention as any of the original claims from the issued
13 patent, and that ordinarily, under such a circumstance, no recapture could be
14 found. Ans. 14-16. The Examiner further made a finding that if all the
15 original claims from the issued patent are canceled, then recapture may then
16 be found. *Id.*

17 The Appellants dispute this. We must agree with the Appellants. We
18 are at a loss to see how the Examiner arrived at this finding as to an
19 exception to the case where claiming entirely new inventions does not
20 involve recapture.

21 First, the original claims remain intact in another divisional. FF 04.
22 There is no requirement that the original claims remain with the first reissue
23 application. Second, the Examiner appears to base the finding on a view that
24 the subject matter that materially narrows the reissue claims should be the
25 overlooked aspect of the original invention *claimed* in the patent. This view

holds up for recapture in claims directed to the same invention as in the original claims, but this is nonsensical for wholly different inventions, if only because with claims to such different inventions, the original invention is not in the claim. Therefore, it is logically inconsistent to require the overlooked aspects be those of the originally claimed invention. We find no authority in the statutes, case law, or even the MPEP for the Examiner's finding. Instead, the Court of Appeals for the Federal Circuit recently held that no recapture exists in such circumstance.

The Board's reliance on this portion of the MPEP is misplaced. This portion of the MPEP deals with claims in which there is no need to apply the recapture rule in the first place. The recapture rule is triggered only where the reissue claims are broader than the patented claims because the surrendered subject matter has been re-claimed in whole or substantial part ... In contrast, this portion of the MPEP addresses reissue claims directed at "additional inventions/embodiments /species not originally claimed." Because the subject matter of these claims was "not originally claimed," it is wholly unrelated to the subject matter that was surrendered during prosecution and the recapture rule is not even triggered.

In re Mostafazadeh --- F.3d ----, 2011 WL 1642830, Slip Opinion 2010-1260 (Fed Cir 5/3/2011).

CONCLUSIONS OF LAW

The rejection of claims 10, 11, 13-24, 27, 33, 38, 39, 41-43, 45-55, 57, 63, 260, and 262 under 35 U.S.C. § 251 as having a defective reissue declaration because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based is improper.

The rejection of claims 10, 11, 13-24, 27, 33, 38, 39, 41-43, 45-55, 57, 63, 260, and 262 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based is improper.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 10, 11, 13-24, 27, 33, 38, 39, 41-43, 45-55, 57, 63, 260, and 262 under 35 U.S.C. § 251 as having a defective reissue declaration because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based is not sustained.
- The rejection of claims 10, 11, 13-24, 27, 33, 38, 39, 41-43, 45-55, 57, 63, 260, and 262 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED

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